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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,831	12/07/2001	Joseph A. Manico	83565SLP	5035

7590 10/10/2008

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EXAMINER	
HANNETT, JAMES M	

ART UNIT	PAPER NUMBER
2622	

MAIL DATE	DELIVERY MODE
10/10/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/017,831	MANICO ET AL.	
	Examiner	Art Unit	
	JAMES M. HANNETT	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 May 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9-11 and 13-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *2-7,9-11,13-22,29 and 30* is/are allowed.

6)☒ Claim(s) *1,23-28 and 31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *3/5/2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 5/13/2008 have been fully considered but they are not persuasive.

In response to the applicants arguments filed in the Pre-appeal brief conference request filed 5/13/2008. The determination by the Pre-appeal conference was that the examiners current grounds of rejection based on the interpretation of the references was proper. However, it was determined by the conference that the examiner was incorrect in allowing Claim 24 and that Claim 23 and 24 should have been rejected under 35 U.S.C. 101 as being non-statutory. Thus the office action is not ready for appeal. Therefore, due to the new grounds of rejection for Claims 23 and 24, Prosecution has been reopened and **this action has been made NON-FINAL.**

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 23 and 24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claimed image product is nothing but an image either on a piece of paper or see page 12 of the spec. Furthermore, the claims are written as a product by process claim. Therefore, the patentability is determined based on the product itself, i.e. image product. Therefore, the claims are rejected under 101 as being printed matter (image printed on paper) and is therefore, non-statutory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1: Claims 1, 23, 25, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,429,923 Ueda et al.

2: As for Claim 1, Ueda et al teaches on Column 1, Lines 26-35 and depicts in Figure 1, 2, and 9 a method of digitizing an image, comprising the steps of: The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system from a first location to a second location. Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed. This is viewed as the service provider receives the images to be digitized from a user at the second location. Ueda et al teaches on Column 35, Lines 37-42 that the service provider is equipped with a film scanner and a flat bed scanner, therefore the operator in the photo-shop scans the image at the second location (photo-shop) using the portable imaging system to produce a digital image; Ueda et al teaches on Column 36, Lines 55-67 and Column 38, Lines 1-9 that the photo-shop operator will take credit card information and order request information from a customer, this is viewed as the service provider receives an order request associated with the digital image from the user. Furthermore, Ueda et al

depicts in Figure 9 and teaches on Column 71, Lines 10-50 that if the photo-shop is unable to perform all of the desired imaging services the images can be transmitted to the main photo-finishing center or a truck will arrive at the photo-shop and pickup the images and bring them to the photo-finishing processing center. This is viewed as the service provider providing the digital images to a fulfiller (photo-finishing center) for fulfillment of the order request. The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system from a first location to a second location. However, Ueda et al does not discus the specifics of the size of the photographic processing apparatus and is silent as to if the device can be small enough to by hand held and small enough for the service provider to carry it by hand.

Official Notice is taken that it was notoriously well known in the art to reduce the size of image processing apparatus such as scanners to as small a size as possible. This is advantageous because it allows the device to take up less space and enables the device to be easily moved.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to reduce the size of the image processing apparatus in order to allow the device to take up less space and enables the device to be easily moved by hand.

3: As for Claim 23, Ueda et al teaches forming an image from the system. Therefore, Ueda et al teaches an image product produced in accordance with the method of claim 1.

4: As for Claim 25, Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed. Furthermore, Ueda et al teaches reading the contents of the PC memory card to develop images. Therefore, in order to read the contents of the PC memory card it is inherent that the system of Ueda et a teaches a PC computer storage product (memory) having at least one computer storage medium having instructions stored therein (code to read out the contents of the memory card) causing one or more computers to perform the method of claim 1.

5: As for Claim 26, Ueda et al teaches on Column 1, Lines 26-35 and depicts in Figure 1, 2, and 9 a method of producing a print from a visual image (printing out images), comprising the steps of: transporting a portable imaging system to a first location; The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system to a first location. Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed. This is viewed as the service provider receives the images to be digitized from a user at the first location. Ueda et al teaches on Column 35, Lines 37-42 that the service provider is equipped with a film scanner and a flat bed scanner, therefore the operator in the photo-shop scans the image at the first location (photo-shop) using the portable imaging system to produce a digital image. This is viewed by the examiner as scanning the hard copy document at the first location using the portable imaging system to produce a digital image. The

system is viewed by the examiner to be portable as a result of the wheels depicted in Figure 3. Ueda et al further depicts in Figures (3 and 5) that the portable photofinisher (600) is provided with wheels (302). Although the specification of Ueda et al does not specifically discuss the wheels or when the photofinisher will be moved, It is clear from in Figures (3 and 5) that the photofinisher is inherently designed to be moved from a first location to a second location. However, Ueda et al does not discus the specifics of the size of the photographic processing apparatus and is silent as to if the device can be small enough to by hand held and small enough for the service provider to carry it by hand.

Official Notice is taken that it was notoriously well known in the art to reduce the size of image processing apparatus such as scanners to as small a size as possible. This is advantageous because it allows the device to take up less space and enables the device to be easily moved.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to reduce the size of the image processing apparatus in order to allow the device to take up less space and enables the device to be easily moved by hand.

6: As for Claim 27, Ueda et al teaches on Column 1, Lines 26-35 and depicts in Figure 1, 2, and 9 a method of digitizing an image. The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system to a first location. Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs,

negatives, and PC memory cards, etc with images on them which they want to be developed. This is viewed as the service provider receives the images to be digitized from a user at the first location. Ueda et al teaches on Column 35, Lines 37-42 that the service provider is equipped with a film scanner and a flat bed scanner, therefore the operator in the photo-shop scans the image at the first location (photo-shop) using the portable imaging system to produce a digital image. This is viewed as accessing the image to be digitized at the second location and scanning the image at the second location using the portable imaging system to produce a digital image. Ueda et al teaches on Column 36, Lines 32-60 and Column 37, Lines 34-50 that the scanned image is digitized and stored in memory. Furthermore, Ueda et al teaches generating an order request associated with the stored digital image However, Ueda et al does not discus the specifics of the size of the photographic processing apparatus and is silent as to if the device can be small enough to by hand held and small enough for the service provider to carry it by hand.

Official Notice is taken that it was notoriously well known in the art to reduce the size of image processing apparatus such as scanners to as small a size as possible. This is advantageous because it allows the device to take up less space and enables the device to be easily moved.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to reduce the size of the image processing apparatus in order to allow the device to take up less space and enables the device to be easily moved by hand.

7: Claims 28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,429,923 Ueda et al in view of US 2004/0109147 A1 Redd et al.

8: As for Claim 29, Ueda et al teaches an imaging photo-developing system that can receive images from a user to be printed. However, does not teach that the system can record audio input corresponding to the image in the portable imaging system.

Reed et al teaches on Paragraph [106] a system for printing images and teaches that it is advantageous to enable a system to capture audio information from a user, digitizing the audio and encoding it on the back of the images that are printed. The Reed teaches that this is advantageous because it allows a user to encode a message onto the image so that a message associated with the images can be played back at a later time and therefore, help a user better remember the contents of the captured picture.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to enable the system of Ueda et al to capture and encode audio information onto the back of the printed pictures as taught by Reed et al in order to allow a user to encode a message onto the image so that a message associated with the images can be played back at a later time and therefore, help a user better remember the contents of the captured picture.

9: In regards to Claim 30, Ueda et al teaches an imaging photo-developing system that can receive images from a user to be printed. However, does not teach that the system can record audio input corresponding to the image in the portable imaging system.

Reed et al teaches on Paragraph [106] a system for printing images and teaches that it is advantageous to enable a system to capture audio information from a user, digitizing the audio and encoding it on the back of the images that are printed. The Reed teaches that this is advantageous because it allows a user to encode a message onto the image so that a message associated with the images can be played back at a later time and therefore, help a user better remember the contents of the captured picture.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to enable the system of Ueda et al to capture and encode audio information onto the back of the printed pictures as taught by Reed et al in order to allow a user to encode a message onto the image so that a message associated with the images can be played back at a later time and therefore, help a user better remember the contents of the captured picture.

Allowable Subject Matter

10: Claims 2-7, 9-11, 13-22, 29 and 30 are allowed

The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach the method of transporting a portable imaging system to a first location; receiving a hardcopy document from a user at the first location, the hard copy document containing the visual image; scanning the hard copy document at the first location using the portable imaging system to produce a digital image; and transporting the portable imaging system to a second location remote from the first location. Furthermore, the prior art does not teach the method of sequentially

transporting a portable imaging system from a first location; accessing the image to be digitized at the second location; scanning the image at the second location using the portable imaging system and storing the digital image in memory disposed in the portable imaging system and generating an order request associated with the stored digital image.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Hannett whose telephone number is 571-272-7309. The examiner can normally be reached on 8:00 am to 5:00 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564 The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/James M. Hannett/
Primary Examiner
Art Unit 2622

JMH

October 10, 2008